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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,873	10/31/2003	Martin T. Gerber	P-8436.05US	2001
27581	7590	10/04/2006	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			EVANISKO, GEORGE ROBERT	
			ART UNIT	PAPER NUMBER

3762

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,873	<b>Applicant(s)</b> GERBER ET AL.	
	<b>Examiner</b> George R. Evanisko	<b>Art Unit</b> 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/31/03, 5/24/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 16-20 are objected to because of the following informalities:

In claim 16, line 4, a comma is needed after “connector” to separate the connector from the electrode. In line 6, the second occurrence of “extending” should be deleted. In line 7, the second occurrence of “and” should be “an”. In claim 17, line 4, “element” should be deleted. In claim 20, lines 3 and 5, “element” should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 16 is rejected under 35 U.S.C. 102(b and/or e) as being anticipated by Machek et al (5954761). Machek shows the lead body, 11, mesh electrode (either 40A or 40 B) having lattice framing windows (e.g. figures 3, 7, etc) and the connector, 12. Machek is capable of meeting the functional use recitations presented in the claim of possessing sufficient mechanical flexibility and small diameter to be inserted through a foramen since Machek’s lead is inserted through the veins, is flexible (column 3, line 55), has expandable/flexible mesh electrodes, and can be placed in numerous small veins in the heart (column 3, lines 45-53). It is noted that this

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case is a CIP and the parent of this case did not disclose the mesh electrode. Therefore this reference is a 102b reference, in the alternative, it is listed as a 102e reference.

Claims 17-19 are rejected under 35 U.S.C. 102(b and/or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Machek et al. Machek states that multiple conductors are provided to electrodes 40A and 40B from the connector and that the electrodes are used for multiple pacing and sensing functions (column 4, lines 48-59) and/or one can pace/sense in ventricle while the other pace/senses in atrium (column 7) and therefore the lead would inherently have a second conductor connected to a second connector. It is noted that either mesh electrode could be the proximal or distal ring electrode.

In the alternative, Machek discloses the claimed invention except for the second ring electrode being connected to a second conductor and second connector. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Machek, with the second conductor and second connector since it was known in the art that leads use additional electrodes and connectors to provide therapy to other areas in the body and to provide bipolar sensing and stimulation with the same lead.

Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brucker et al (5643197). Brucker includes a lead body, 22, with distal and proximal ring electrodes, 30, connector, 36/40, and a flexible mesh electrode (e.g. col 3, lines 52-62) with lattice framing windows (figure 15, column 8). Brucker is capable of meeting the functional use recitations presented in the claim of possessing sufficient mechanical flexibility and small diameter to be inserted through a foramen since Brucker's lead is inserted through the veins, is flexible, and is a mesh electrode.

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Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Spreigl et al (6161029)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Spreigl discloses the lead (eg 12), connector, 26, having distal ring electrodes, 38 and 40, using separate conductors connected to the connector, and expandable/flexible electrode, 30. In addition, Spreigl incorporates by reference three patents, 4733665, 5078726, and 5242451, showing the use of a mesh electrode with lattice framing windows. Spreigl is capable of meeting the functional use recitations presented in the claim of possessing sufficient mechanical flexibility and small diameter to be inserted through a foramen since Spreigl's lead is inserted through the veins, is flexible, and is a mesh electrode.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machek et al or Brucker.

Machek discloses the claimed invention having two ring/mesh electrodes which can be considered the proximal or distal ring electrode except for the additional distal/proximal ring electrode, conductor, and third connector. Brucker discloses the use of multiple proximal and distal ring electrodes and conductors, except for the third connector. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Machek or Brucker, with an additional distal/proximal ring electrode, conductor, and third connector since it was known in the art that patient leads incorporate additional distal/proximal ring electrodes, conductors, and connectors to provide additional therapy to the patient or sensing from the patient using one lead instead of multiple leads.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spreigl et al.

Spreigl discloses the claimed invention except for the proximal ring electrode, conductor, and third connector. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to modify the lead as taught by Spreigl, with an additional proximal ring electrode, conductor, and third connector since it was known in the art that patient leads incorporate additional proximal ring electrodes, conductors, and connectors to provide additional therapy to the patient or sensing from the patient using one lead instead of multiple leads.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scott is another teaching of a mesh electrode with ring electrodes.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945.

The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
George R Evanisko  
Primary Examiner  
Art Unit 3762

9/23/6

GRE  
September 27, 2006